

REMARKS

Claims 1-18 remain in the application.

The office action objects to the amendment filed 10/06/03 under 35 U.S.C. 132 for ostensibly adding new matter by amending the specification to disclose a control module that includes ***only enough outputs*** to connect respective cells of a portion of the array to the fluid supply system via the control module, etc. According to the office action these changes are not supported in the original application.

Similarly, the action rejects claims 1-18 under 35 U.S.C. 112, first paragraph, because claims 2-18 depend from claim one, and claim one recites that the control module includes ***only enough outputs*** to connect respective cells of a portion of the array to the fluid supply system via the control module (which allows the array to be conformed to any one of a plurality of different vehicle types by connecting to the limited number of outputs only those cells that are appropriate or intended for use in a given vehicle type). According to the action, the originally filed specification doesn't support this added subject matter.

In response to both the objection to the amendment and the rejection of claims 1-18, please note that the first two paragraphs of page 19 of the original specification support the above amendments:

The aforesaid system provides a greater degree of customization for such end users. The systems of Figures 7 and 8 will allow the vehicle manufacturer ***to activate a limited number of zones*** throughout the seat surface. The seat will be assembled with air cells placed in a number of key zones potentially numbering ***more than a dozen***. A control module and pump will be located within the seat and they will be ***designed to control a limited number of zones, typically three or four*** depending on the switch

configuration that is selected as described above. The manufacturer or dealership will be able to activate particular zones by connecting the hoses attached to given zones to the **limited number of outputs** from a selected control module that will be configured to operate **the zones selected**. Such connection step or process can take place at the seat assembly plant, the automobile manufacturing facility, the dealership or could even be performed by the end-user as long as instructions and access is provided.

The inventive process is providing a seat or automobile manufacturer a preprogrammed control module; a number of air cell arrays in the seat and a connection process in which **a limited number of hose connections** on the selected control module are **selectively connected to selected ones** of the air cell zones or arrays including the novel steps of **linking selected zones to a specified number of control module outputs**. (Emphasis added).

In these two paragraphs the inventors disclose selecting a control module that, as the amended claim 1 recites, includes only enough outputs to service a portion of the air cell array, and then connecting those outputs on to selected ones (typically three or four) of the available air cell zones (potentially more than a dozen).

The applicant has, however, amended the terminology of claim 1 and the corresponding portion of the invention summary to more closely correspond to that used in the first two paragraphs of page 19 of the original specification. As amended, the applicant maintains that claim 1 and the invention summary are in acceptable form.

The applicant has further amended the claims and invention summary to replace the term "array of air cells" with the term "plurality of air cells" to avoid confusion with portions of the specification that refer to multiple air cell arrays.

The office action rejects claims 1-16 under 35 U.S.C. § 102(e) as being anticipated by US 6203105 to Dick Rhodes (the Rhodes patent). According to the

Action, the Rhodes patent discloses all the features described in claims 1-16 of the application.

The applicant maintains that the Rhodes patent does not anticipate any of claims 1-16. The Rhodes patent neither discloses nor suggests:

- that its control module be configured to connect to and operate only a limited number of air cells selected from a plurality of air cells;
- that the control module might include only a limited number of outputs corresponding to the limited number of air cells and connecting respective ones of the limited number of air cells to the fluid supply system via the control module;
- that a plurality of air cells might be conformed to any one of a number of different vehicle types by connecting to the limited number of outputs only those cells selected from the plurality of air cells as being appropriate or intended for use in a given vehicle type.

The office action does not state why it rejects claims 2-16 under 35 U.S.C. § 102(e). The applicant therefore asks that the examiner identify in the Rhodes patent where the recited limitations of these claims are disclosed, and then provide the applicant an opportunity to respond. The applicant has been unable to locate any such disclosure and maintains that Rhodes does not anticipate these claims.

The office action rejects claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over the Rhodes patent because the method steps described in those claims “would inherently be incorporated within the use of the invention.” With this statement it appears that the Action is arguing that it’s inherent in the seating system design disclosed in the Rhodes patent that certain air cells (that are not to be used in a given application) be deactivated by disconnecting them. In response, the applicant maintains that inherency requires that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that persons of ordinary skill would so recognize it. *Continental Can Co., U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 1268-69 20

U.S.P.Q.2d 1746, 1749-50 (Fed.Cir.1991). Inherency may not be established by probabilities or possibilities. *Id.* The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In other words, to be inherent, a claimed process or method step must have no alternative – the step must *necessarily* be followed when the invention is practiced. That is not the case here. There are any number of ways that individual cells could be deactivated, e.g., by closing valves, by puncturing the cells, or by fixing an exhaust valve permanently in an open position to prevent the accumulation of air. Also, as a preliminary matter, there's nothing in the Rhodes patent that either discloses or suggests that certain air cells might be deactivated, disconnected, or, in some fashion, cut-off to suit different applications. The office action has provided no evidence that the Rhodes system must (rather than might) include the steps of deactivating certain cells by either disconnecting the cells to be deactivated or connecting only the cells that are not to be deactivated as recited in claims 17 and 18. Instead, what the Rhodes patent actually discloses is temporary deactivation of cells by selectively operating valves. For these reasons the applicant maintains that claims 17 and 18 are patentable over the Rhodes patent.

Claims 1-18 recite patentable subject matter and are allowable. Therefore, the applicant respectfully submits that the application is now in condition for allowance and respectfully solicits such allowance. Please favorably reconsider the outstanding office action.

Please enter the amendments under the provisions of 37 CFR §1.116 and reconsider claims 1-18 in view of the foregoing amendments and remarks.

August 16, 2004

I authorize the Assistant Commissioner to charge any deficiencies, or credit any overpayment associated with this communication to Deposit Account No. 50-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

REISING, ETHINGTON, BARNES, KISSELLE, P.C.

A handwritten signature in black ink, appearing to read "M J Schmidt", is written over a horizontal line.

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